



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,352	12/11/2003	Jukka Salonen	0365-0638PUS1	3575
2292 7590 05/28/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER SALLARD, SHANNON S				
ART UNIT 3628		PAPER NUMBER		
NOTIFICATION DATE 05/28/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

**Application No.**

10/734,352

**Applicant(s)**

SALONEN, JUKKA

**Examiner**

SHANNON S. SALIARD

**Art Unit**

3628

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 4/23/09

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant has currently amended claims 19 and 22. Claims 1-18, 20, and 24-27 have been cancelled. No claims have been newly added. Thus, claims 19 and 21-23 remain pending and are presented for examination.

### ***Response to Arguments***

2. Applicant's amendments filed 05 February 2009, with respect to the objection to the Abstract, have been fully considered and are persuasive. Thus, the objection to the Abstract has been withdrawn.
3. Applicant's amendments, filed 05 February 2009 with respect to the objections of claims 19 and 22, have been fully considered and are persuasive. Thus, the objections of claims 19 and 22 have been withdrawn.
4. Applicant's amendments filed 05 February 2009, with respect to the rejection of claim 22 under 35 U.S.C. 112, First Paragraph, have been fully considered and are persuasive. Thus, the objections of claims 19 and 22 have been withdrawn.
5. Applicant's arguments with respect to rejections of claims 19 and 21-23 under 35 U.S.C. 103 (a) have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 19 and 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, there is no support within the specification for the limitation "assigning a unique reply address to an SMS message from a multiplicity of available predefined reply addresses". While in paragraph [] of the specification assigning the addresses at random are discussed, there is no mention of the addresses being predefined.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 19, 21, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamanen [US 6,085,100] in view of Kagi [US 2002/0028686] and Kupsch et al [US 7,149,537].

As per **claims 19 and 22**, Tarnanen discloses a) assigning a unique reply address to an SMS message from a multiplicity of available reply addresses [col 2, lines 34-37, and col 7, lines 21-41];

b) sending the SMS message to the client at the client identifier address [Fig. 5, step 40]; and

c) replying to the SMS message at the unique reply address [Fig. 6, step 50].

Tarnanen does not disclose when a SMS message is received at the unique reply address authenticating the client. However, Kagi discloses when a SMS message is received at the unique reply address authenticating the client [0029]. It would have been obvious to one of ordinary skill in the art to include in the SMS communication system of Tarnanen the ability to authenticate the client as taught by Kagi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Tarnanen discloses assigning a unique reply address to an SMS message from a multiplicity of available reply addresses [col 2, lines 34-37, and col 7, lines 21-41]. The sole difference between Tarnanen and the claimed subject matter is that Tarnanen does not disclose that the reply addresses are predefined. However, Kupsh et al discloses that the reply addresses are predefined [col 6, lines 17-30]. Kupsh et al shows that the use of a predefined reply address for SMS messaging was known in the prior art at the time of the invention. Since each individual element and its function are shown in the

prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself -- that is in the substitution of the predefined address of Kupsh et al for the reply address of Tarnanen. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

As per **claim 21**, Tarnanen further discloses wherein the method further includes storing the reply in a matrix including a first axis indexed by client calling line identifier number and a second axis indexed by reply address [col 6, lines 19-57; Fig. 4].

As per **claim 23**, Tarnanen further discloses wherein the client's identifier address includes an identifier chosen from the group consisting of a client's A-subscriber's number, Calling Line Identity, e-mail address and IP address [col 6, lines 27-30].

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

***Commissioner of Patents and Trademarks  
Washington, D.C. 20231***

Or faxed to:

**(571) 273-5587** [Informal/ Draft Communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Shannon S Saliard  
Examiner  
Art Unit 3628

/S. S. S./  
Examiner, Art Unit 3628

/John W Hayes/  
Supervisory Patent Examiner, Art Unit 3628